Serial No. 10/809,278
Amendment and Response to
Office Action mailed July 5, 2006

Filed: March 25, 2004

REMARKS

Claims 15-33 are pending in the present application. Claims 9-14 have been canceled pursuant to 37 CFR §116 to reduce the number of issues for appeal. Reconsideration of the pending Claims is respectfully requested in view of the amendments to the Claims and the following remarks.

The 35 U.S.C. §112 first paragraph rejections

Claims 9-14 were rejected pursuant to 35 U.S.C. §112 first paragraph for failing to comply with the written description requirement. Claims 9-14 have been canceled, rendering this rejection moot.

The 35 U.S.C. §103(a) Claim Rejections

Claims 9-12, 14-15 and 27-33 were rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2004/0078752 to Johnson. (hereinafter "Johnson") in view of U.S. Patent No. 6,598,076 to Chang et al. (hereinafter "Chang"). In addition, Claim 13 was rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over Johnson, in view of Chang, and further in view of U.S. Patent Publication No. 2002/0143885 to Ross. (hereinafter "Ross"). Also, Claims 16-20 were rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over Johnson, in view of Chang, and further in view of U.S. Patent Publication No. 2006/0004922 A1 to Lahti et al. (hereinafter "Lahti"). Further, Claims 21-26 were rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over Johnson in view of Chang, and further in view of U.S. Patent Publication No. 2003/0120496 A1 to Alfred et al. (hereinafter "Alfred"). Applicant respectfully traverses these rejections since each and every limitation provided in Claims 15-33 are not taught, suggested, or disclosed by the cited references either alone or in combination. Thus, a *prima facie* case of obviousness has not been established.

Claims 15-20

The method of Claim 15 describes the steps of providing a first application and a second application both operable on a communication terminal. The first application is operable to generate an email message, to transmit an email message to an email server, to receive an email message from said email server, or to open an email message. The second application is

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executable to generate an email message or to open an email message. On page 7 of the office action mailed July 5, 2006, it was asserted that Col. 1 lines 28-44 of Chang teach "a similar method comprising providing a second application operable on a communication terminal." Applicant respectfully traverses this assertion.

Column 1 lines 28-44 of Chang describe an email with an attachment that is retrieved by a receiving computer. (Col. 1 lines 32-33). Chang also describes programs resident on the receiving computer that can be started and used to open the attachment. (Col. 1 lines 40-42) Nowhere does the cited portion of Chang describe a second application executable to generate an email message or open an email message. To the contrary, Chang is focused solely on opening an electronic attachment to an email with a program resident on the receiving computer. In fact, the cited portion of Chang only alludes to the existence of a single application operable to transmit and receive an email message, and very clearly does not teach or suggest a first application and a second application as described in Claim 15. Even if Chang's programs resident on a receiving computer were somehow construed as equivalent to the second application of Claim 1, Chang's programs still teach away since Chang's programs open an attachment to an email, and clearly do not generate or open an email as described in Claim 15. Further, as indicated in the office action mailed July 5, 2006, Johnson also fails to teach or suggest a second application as described in Claim 15. Accordingly, neither Johnson nor Chang, alone or in combination, provide the third basic criteria for obviousness that must be met, which is that all the limitations of the claims must be taught or suggested by the combination of the cited references. (see MPEP 2143)

In addition, Claim 15 describes determining with said first application operable on a communication terminal if said email message is compatible with said first application or said second application operable on said communication terminal. The cited portions of Johnson, on the other hand, describe determination of whether electronic documents associated with the email message can be processed by a recipient mobile information device, and an identifier of the associated electronic document(s) is generated. (Paragraph 109) Accordingly, Johnson teaches away from determining compatibility of an email message, since Johnson is focused on attachments to an email message, not the email message itself, and thus suggests that the email message itself is always compatible with the email circuit, routine or application (655). (Paragraph 92) Also, Johnson's access server system fails to teach or suggest storing data in a folder designated with said email message as described in Claim 15, and further described in

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Claim 17. To the contrary, Johnson fails to even mention or suggest storing data in a folder designated with an email message. In fact, the cited portions of Johnson teach away by indicating that email messages are not stored at all, but rather are transmitted by the access server system to a mobile information device (MID). (paragraph 110)

On page 11 of the office action mailed July 5, 2006, it was asserted that Lohita teaches reading an identifier included in a header of said email message. Applicant respectfully traverses this assertion since the cited portions of Lohita describe a header of a short message service (SMS), which, as known to those skilled in the art, is an entirely different type of message, and actually teaches away from a header of an email message as described in Claim 16. Also, Lohita describes an identifier to direct a payload of a message to an application, not an identifier to indicate compatibility of an email message itself with a first application or a second application as described in Claim 16. The table and folder described in Claim 17, and the step of obtaining a message identification as described in Claim 19 are also not taught, or suggested by the cited references.

Claims 21-26

Claim 21 describes the steps of providing a first application and a second application both executable on said communication terminal to generate an email message and to open an email message. Neither Johnson nor Chang, either alone or in combination, describe first and second applications executable on a communication terminal to generate email messages. Applicant respectfully traverses the assertion in the office action mailed July 5, 2006 that Chang describes a second application executable to generate email messages, since Chang fails to describe two email applications executable on a communication terminal. To the contrary, as previously discussed, both Johnson and Chang describe only one application executable to generate an email message, as previously discussed.

In addition, contrary to the assertions in the office action mailed July 5, 2006, Johnson fails to teach or suggest both a first application and a second application executable to open an email application. To the contrary, Johnson describes an email circuit, routine or application (655) that enables a user to read and write email, and a document viewer circuit, routine or application (660) that enables a user to view mobile information device-enabled documents. (paragraph 92) Johnson also describes that email messages with electronic file attachments are stored as email

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files and accessed by either the email circuit, routine or application (655) or the document viewer circuit, routine or application (660). (paragraph 96 and 97) However, Johnson does not teach, suggest, or disclose that the document viewer circuit, routine or application (660) can open an email message as described in Claim 21. To the contrary, Johnson clearly describes that the document viewer circuit, routine or application (660) is used to view documents that are attachments to email messages, as previously discussed.

Claim 21 also describes generating an email message with said second application, and with said second application enabling said first application to transmit said email message. On page 13 of the office action mailed July 5, 2006, it was asserted that Alfred teaches a second application generating an email message. Applicant respectfully traverses this assertion since the cited portion of Alfred describes that compatibility problems can arise with reading attachments to emails when a receiver and sender have different email providers or the attachments are created with different programs. The cited portions of Alfred are completely silent on a first application executable on a communication terminal __and__ a second application executable on the communication terminal to generate an email message and open an email message as described in Claim 21.

In addition, the office action mailed July 5, 2006 fails to assert that any of the cited references meet the limitation of said second application enabling said first application to transmit said email message as described in Claim 21. Instead, the limitation is simply disregarded entirely. The MPEP requires that each and every limitation be considered. (MPEP 2143.03) Accordingly, it is respectfully request that the rejection of Claim 21 be withdrawn as being improperly rejected.

Further, on page 14 of the office action mailed July 5, 2006, it was asserted that Claims 22-26 were obvious in view of the combination of Johnson, Chang and Alfred, and that Chang teaches or suggests the limitations of Claims 22 and 24-26. To the contrary, Applicant respectfully asserts that neither the cited portions of Chang nor Johnson teach or suggest storing an email generated with a second application in a transmission folder used by a first application as described in Claim 22, or detecting association of said email message with said transmission folder as described in Claim 23, and therefore cannot possibly provide the basis for the rejections of these Claims.

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Claims 27-33

Claim 27 describes a first email application and a second email application operable in a mobile communication terminal to generate or open email messages. None of the cited references, either alone or in combination, teach or suggest a first email application and a second email application as described in Claim 27. To the contrary, all of the cited references consistently teach only a single email application operable to generate or open email messages. Accordingly, none of the cited references can possibly teach wherein said second email application is configured to enable said first email application to transmit and receive email messages that are otherwise processed only with said second email application as further described in Claim 27. Applicant respectfully traverses the assertion in the office action mailed July 5, 2006 that the cited portions of Chang teach or suggest such limitations. To the contrary, the cited portion of Chang simply describes email with electronic attachments that can be opened with software. Clearly, Chang does not describe any form of a second email application that enables a first email application to transmit and receive email messages otherwise processed only with the second email application as described in Claim 27. In addition, even if the software taught by Chang could be construed as a second email application, Chang very clearly describes that such software is used to open electronic attachments included in an email, not open an email message as described in Claim 27.

On page 8 of the office action mailed July 5, 2006 it is also asserted that Chang teaches said first email application is operable to receive an email message and determine if said email message is compatible with said first email application or said second email application as describe in Claim 28. Applicant respectfully traverses this assertion since Chang fails to teach or suggest any form of determination by a first email application, and clearly does not describe determination if an email message is compatible with a first email application or a second email application as described in Claim 28. In addition, neither Johnson nor Chang, alone or in combination, teach or suggest a predetermined reception folder, and a folder identified with a received email message as described in Claim 29, a transmission folder as described in Claim 30, a second email application operable to generate a folder as described in Claim 31, or first and second email applications operable to generate respective first and second types of email messages as described in Claim 32. Contrary to the assertions on pages 8 and 9, Chang describes various software that can be used to open electronic attachments included in email, not email messages, and makes no mention of any type of folder, or different types of email messages.

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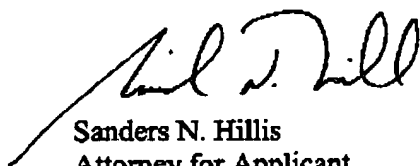
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Conclusion

    For at least the foregoing reasons, none of the cited references either alone or in combination, provides the third basic criteria for obviousness that must be met, which is that all the limitations of the claims must be taught or suggested by the combination of the cited references. (see MPEP 2143) In addition, Applicant respectfully asserts that many of the rejections are improper because the basis for the rejection is not clearly and specifically explained since there is no citation of references at all, or Applicant is unable to find basis in cited portions of the references for the limitations the references are asserted to teach or suggest. (See the requirements of MPEP 2660 (III) "clearly set forth grounds for rejection . . . and reasons supporting grounds", and MPEP 2260.01 "dependent claim should not be . . . rejected merely because it depends on a rejected . . . claim.")

    For at least the foregoing reasons, the presently pending Claims 15-33 are patentable over the references of record. Accordingly, with this amendment and response, Applicant believes that Claims 15-33 are allowable, and respectfully requests the issuance of a Notice of Allowance for this application. Should the Examiner deem a telephone conference to be beneficial in expediting allowance/examination of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

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Respectfully submitted,

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